



18 SEP 2002

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In re Application of GIRAUD et al
U.S. Application No.: 09/869,768
Int. Application No.: PCT/FR99/03317
Int. Filing Date: 30 December 1999
Priority Date: 31 December 1998
Attorney Docket No.: CR1PCT/lw
For: DISPENSER OF OBJECTS

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DECISION

This is in response to applicant's "Petition to Withdraw Holding of Abandonment Under 37 CFR § 1.181" filed 29 August 2002, "Supplemental to the Petition to Withdraw Holding of Abandonment Under 37 CFR § 1.181" filed 16 September 2002, and "Petition Under 37 CFR § 1.47" filed 24 May 2002.

BACKGROUND

On 30 December 1999, applicant filed international application PCT/FR99/03317, which claimed priority of an earlier France application filed 31 December 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 13 July 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 21 July 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 02 July 2001 (30 June 2001 was a Saturday).

On 29 June 2001, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 07 September 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 06 February 2002, the DO/EO/US mailed a duplicate Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905).

On 24 May 2002, applicant filed a response to the Notification of Missing Requirements mailed 06 February 2002, including a petition under 37 CFR 1.47(a).

On 26 July 2002, the DO/EO/US mailed a Notice of Abandonment, which stated that the present application is abandoned for failure to timely respond to the "Notice to File Missing Parts (Notice) mailed on 02/07/2002".

On 09 August 2002, applicant filed a petition under 37 CFR 1.181 to withdraw the holding of abandonment.

On 23 August 2002, this Office mailed a decision dismissing the 09 August 2002 petition, vacating the 26 July 2002 Notice of Abandonment, and directing the DO/EO/US to prepare a Notification of Abandonment (Form PCT/DO/EO/909).

On 29 August 2002, applicant filed a renewed petition under 37 CFR 1.181.

On 30 August 2002, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909), which indicated that the application is abandoned as to the United States for failure to timely respond to the Notification of Missing Requirements mailed 07 September 2001.

On 16 September 2002, applicant filed a supplement to the renewed petition under 37 CFR 1.181.

DISCUSSION

I. Petition under 37 CFR 1.181

According to the Official Gazette at 1156 OG 53 and MPEP 711.03(c), a petition to withdraw a holding of abandonment based on failure to receive an Office communication must include: (1) a statement by the practitioner that the Office communication was not received by the practitioner, (2) a statement by the practitioner that he searched the application file jacket and docket records and that the search indicates that the Office communication was not received, and (3) a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

With regard to item (1) above, applicant's representative has provided the required statement.

With regard to item (2) above, applicant's representative has provided the required statement.

With regard to item (3) above, applicant's representative has furnished a docket record listing all responses due to the USPTO for 07 November 2001, i.e. the due date for response to the Notification of Missing Requirements mailed 07 September 2001. The docket record reflects a lack of any response due to a Notification of Missing Requirements for the relevant date. Accordingly, the evidence of record is sufficient to reasonably establish that the Notification of Missing Requirements mailed 07 September 2001 was never received by applicant.

II. Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by inventor Roger Nobilet on his own behalf and on behalf of nonsigning inventor Jean-Pierre Giraud.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

* * *

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The present petition fails to state whether Mr. Giraud cannot be located or refuses to sign. Furthermore, while the petition states that letters were sent to Mr. Giraud (see affidavit of M. Jean Calvo), English language translations of the letters have not been provided. Therefore, it would not be reasonable to conclude at the present time that Mr. Giraud either cannot be located or refuses to sign.

Applicant is advised that a diligent effort to locate a nonsigning inventor should extend beyond postal mail. More specifically, applicant should provide evidence of additional attempts to locate the nonsigning inventor, e.g. by obtaining a forwarding address and by trying to reach the nonsigning inventor by telephone, electronic mail, and through his former employer, former coworkers, friends, and family members. In the event refusal to sign is alleged, an appropriate affidavit from the person(s) with firsthand knowledge of the evidence set forth in MPEP 409.03(d) as discussed above should be provided.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

CONCLUSION

For the reasons set forth in §I above, the renewed petition under 37 CFR 1.181 is **GRANTED**.

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 30 August 2002 is hereby **VACATED**.

For the reasons set forth in §II above, the petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition under 37 CFR 1.47(a) is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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